

## REMARKS

In an Office Action dated 06 April 2006, the Examiner rejects all pending claims 36-59 on prior art grounds. In reply, Applicant submits the present Remarks which address and overcome the outstanding prior art rejections; entry and consideration hereof is respectfully requested.

Applicant now addresses the Examiner's rejections in turn.

**Claims 36, 38-40, 43, 44, and 53** are rejected under 35 U.S.C. 102(b) as allegedly lacking novelty in view of European Patent No. 0 897 175 to Clarke.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the \* \* \* claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully submits that Clarke fails to disclose all of the limitations of the rejected claims and thus does not anticipate the claims. Particularly, claim 36 recites a sound shielding element comprising, inter alia, at least one panel or layer and a plurality of small perforations formed in said at least one panel or layer, where the panel has a thickness between 0.05 and 0.3 mm. Clarke, on the other hand, discloses an acoustical and structural microporous sheet having a thickness of 0.015 inch, i.e., 0.38mm. See, e.g., paragraph 0011. Accordingly, Clarke clearly does not teach all of the limitations of claim 36, therefore the outstanding novelty rejection is improper and may not be maintained; reconsideration and withdrawal thereof is respectfully requested.

Claim 39, 40, 43, and 44 variously depend from novel independent claim 36 and are thus correspondingly novel; reconsideration and withdrawal of the relevant section 102 rejection is respectfully requested.

As mentioned above, claim 38 is said to lack novelty in view of Clarke. Claim 38 recites a sound shielding element comprising, inter alia, at least one panel or layer and a plurality of small perforations formed in said at least one panel or layer, where the panel is

configured as a three-dimensionally shaped molded part of an underbody lining of motor vehicles. Clarke, to the contrary, discloses “a microporous sheet and a process for its production and use where the sheet has both acoustical and structural functionality by having formed therethrough a plurality of apertures of a size and numbers sufficient to enable the sheet to function as an acoustical noise suppressor while retaining capability of functioning as a structural element.” Paragraph 0001. Specifically, Clarke is directed toward a metallic sheet (preferably titanium) or graphite/glass/carbon reinforced epoxy which provides noise suppression and structural support in aircraft. See, e.g., Paragraphs 0002, 0010, and 0011. In any event, Clarke is limited to a stiff sheet for providing both structural and acoustical properties. Clearly, the reference does not teach a panel configured as a three-dimensionally shaped molded part of an underbody lining of motor vehicles, as required by claim 38. Thus, claim 38 is novel over Clarke; withdrawal of the outstanding rejection is requested.

Claim 53 recites a method of producing a sound shielding element comprising forming a panel fusing or bonding particles or fibers. As discussed above, Clarke concerns a metallic structural member with acoustical properties. Clarke makes no mention of forming its sheet using particles or fibers by fusing or bonding, as required by claim 53. Thus, the claim is not anticipated by Clarke; withdrawal of the rejection is requested.

Accordingly, the section 102 novelty rejections of claims 36, 38-40, 43, 44, and 53 are herein overcome. These claims are not further rejected nor objected and are thus allowable to Applicant.

**Claims 37, 41, 42, 45-52, and 54-59** are rejected under 35 U.S.C. 103 as allegedly being obvious in view of Clarke.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally the prior art reference(s) must teach or suggest all the claim limitations. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1996).

With respect to claims 37, 41, 42, 45-52, and 54-59, Applicant submits that at least

one of these criteria are not met and thus the obviousness rejection may not be maintained.

Claim 37 recites a sound shielding element for protection from the propagation of sound comprising, *inter alia*, at least one panel or layer; and a plurality of small perforations formed in said at least one panel or layer; where the panel is configured as a three-dimensionally shaped molded part and is injection-molded or pressed from synthetic material. As mentioned above, Clarke is specifically directed to a structural sheet (preferably metallic) for jet aircrafts which also provides acoustical properties due to the presence of perforations. Clearly, Clarke does not disclose that its sheet is injection-molded or pressed from synthetic material, as required by claim 37. However, the Examiner states that this would be an obvious design choice in view of the teaching of Clarke. To the contrary, though, one of ordinary skill in the art would not modify Clarke to include injection molded or pressed synthetic material because such material may be viewed as lacking the rigidity or strength required to provide the jet aircraft structural properties sought by Clarke. Accordingly, for at least this reason, claim 37 is inventive and not obvious over Clarke.

Claims 41 and 42 depend from allowable claim 36 and are thus correspondingly allowable. Similarly, claims 54-59 depend from allowable claim 53 and are thus correspondingly allowable.

Claim 45-52 recite sound shielding elements comprising, *inter alia*, at least one panel or layer variously configured as: an underbody lining of a motor vehicle; a roof lining in a passenger compartment of a motor vehicle; an injection-moulded cover unit for covering cables; a hat rack in a motor vehicle; a seat cover in a motor vehicle; door lining; an absorbing tube for air-conducting tubes; and a cover for covering at least part of an internal combustion engine. As conceded by the Examiner, these limitations are not taught or suggested by Clarke which is directed specifically to an engine housing for an airplane.

However, the Examiner asserts that it would have been an obvious matter of design choice for one of ordinary skill in the art to employ the metallic sheet of Clarke as recited in the claims 45-52. Applicant respectfully disagrees. As mentioned above, Clarke is specifically directed to providing a structural member in a jet aircraft where the member also provides an acoustic effect. The structural member of Clarke is inherently rigid and possesses significant weight. Accordingly, the structural member is clearly not suitable for the

underbody of a motor vehicle, nor a roof lining in a passenger compartment of a motor vehicle, nor an injection-moulded cover unit for covering cables, nor a hat rack in a motor vehicle, nor a seat cover in a motor vehicle, nor door lining, nor an absorbing tube for air-conducting tubes, nor for a cover for covering at least part of an internal combustion engine, all as required by claims 45-52.

Thus, the required “suggestion or motivation” is not found in Clarke. Therefore the reference does not render claims 45-52 obvious; reconsideration and withdrawal of the outstanding rejections is requested.

Moreover, with respect to Clarke, it is noted that the reference discloses the use of small perforations so as to maintain the structural integrity of the disclosed sheet. The reference does not teach or suggest Applicants’ claimed relationship between hole diameter, hole to surface ratio, and panel thickness for optimization of sound shielding. That is, the claimed combination may not be derived from Clarke because the reference is particularly directed to the provision of a structural member for jet aircrafts. Modifying Clarke to meet the limitations of Applicant’s claims would render the reference unsuitable to perform its intended function. That is, modifying Clarke to include the hole diameter, hole/surface ratio, and panel thickness of Applicant’s claims would likely forfeit the structural properties required by Clarke. Thus, for at least this reason, Applicant’s claims are not obvious in view of Clarke.

For at least the reasons submitted herein, Applicants respectfully submit that claims 36-59 are novel and non-obvious over Clarke. Withdrawal of the rejections and an indication of allowance is respectfully requested.

The Examiner is invited to contact Applicants’ attorneys at the below-indicated telephone number regarding this Reply or otherwise concerning the present application.

Applicants hereby petition for any necessary extension of time required for consideration and entry of the present Reply.

Please charge any required fees for this Reply, or otherwise concerning the present application, to Deposit Account No. 06-1130 maintained by Applicants' attorney.

Respectfully submitted,

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